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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,312	10/08/2003	Anthony G. Macaluso	13817-005001	7323
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EXAMINER VU, MICHAEL T				
ART UNIT 2617		PAPER NUMBER		
NOTIFICATION DATE 11/26/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

### Office Action Summary

**Application No.**

10/682,312

**Applicant(s)**

MACALUSO, ANTHONY G.

**Examiner**

MICHAEL T. VU

**Art Unit**

2617

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-29, 32-37 and 39-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-29, 32-37 and 39-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 6-29, 32-37, 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eng (US 2002/0077107), in view of Sears (US 2002/0069263), and further in view of Hoffman (US 6,622,017).

**Regarding claims 1, 16, 24 and 32**, Eng teaches a method for providing services to a mobile device (Figure #1, Services, [0004-0007]), the method comprising: receiving a request from the mobile device for choices of available service providers [0004-0007] and associated mobile service subscription choices that include at least a choice of mobile calling plan (Abstract, [0004-0007]);

**But Eng does not clearly teach** sending data to the mobile device relating to identification of the available service providers and the associated mobile service subscription choices, wherein the choices of available service providers and the associated subscription choices are sent to the mobile device over a wireless communication path, the choices of service providers and subscription choices are for selection by a user of the mobile device,

However, Sears teaches sending data to the mobile device relating to identification of the available service providers and the associated mobile service subscription choices [0039-0041], wherein the choices of available service providers [0038-0041] and the associated subscription choices are sent to the mobile device over a wireless communication path [0012-0013], the choices of service providers [0012-0013] and subscription choices are for selection by a user of the mobile device [0039-0041] and

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eng, with Sears' teaching, in order to provide the user with more options for selecting and/or downloading the different service plans, or advertisements such as sales from different providers for saving cost.

**But Eng and Sears do not specifically teach** the subscription choices comprise choices to initiate **or** modify a subscription associated with at least one of the available service providers to enable wireless communications over a wireless network; receiving a selection of at least one of the available service providers and at least one of the associated subscription choices from the mobile device over the wireless communication path; and activating a service corresponding to the at least one selected service provider and at least one associated subscription choice in response to the selection.

However, Hoffman teaches the subscription choices comprise choices to initiate **or** modify a subscription associated with at least one of the available service providers to enable wireless communications over a wireless network (Col. 2, line 17 to Col. 3,

line 67); receiving a selection of at least one of the available service providers (Col. 6, line 54 to Col. 7, line 9) and at least one of the associated subscription choices from the mobile device over the wireless communication path (Col. 5, line 3 to Col. 6, line 53); and activating a service corresponding to the at least one selected service provider (Col. 1, line 19 to Col. 2, 67) and at least one associated subscription choice in response to the selection (Col. 2, line 17 to Col. 3, line 67), and (see Figures #3-4, Mobile Device #5, Display #49 for displaying, Microprocessor, CPU #51, and Memory #53 for storing and executing the applications).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eng and Sears, with Hoffman's system, in order to allow the user access to the selected their own services for saving cost, e.g. discounting to subscribe to use their cellular network services such as bundle services.

**Regarding claim 2**, Eng, Sears, and Hoffman teach the method of claim 1 wherein the request for mobile subscription choices from the mobile device comprises an activation request (Col. 1, line 19 to Col. 2, 67) of Hoffman.

**Regarding claim 3**, Eng, Sears, and Hoffman teach the method of claim 1 wherein the mobile device comprises a mobile phone (Figure #, Col. 2, lines 17-67) of Hoffman.

**Regarding claim 4**, Eng, Sears, and Hoffman teach the method of claim 1 wherein the mobile device is capable of operation with a plurality of service providers (Col. 6, lines 54-67) of Hoffman.

**Regarding claim 6**, Eng, Sears, and Hoffman teach the method of claim 1 wherein the available service providers comprise mobile virtual network operators (See Providers, or Third Party Database, (Col. 6, lines 54-67) of Hoffman.

**Regarding claim 7**, Eng, Sears, and Hoffman teach the method of claim 1 wherein activating a service comprises sending data representing at least one setting for the mobile device (Col. 1, line 19 to Col. 2, 67), with the data being sent over the wireless communication path (Col. 1, line 19 to Col. 2, 67) all of Hoffman.

**Regarding claim 8**, the combination of Eng, Sears, and Hoffman teach the method of claim 7 wherein the at least one setting allows the mobile device to obtain service from the selected service provider (Col. 2, lines 17- 67) of Hoffman.

**Regarding claim 9**, the combination of Eng, Sears, and Hoffman teach the method of claim 7 wherein the at least one setting comprises a preferred roaming list (Col. 1, line 19 to Col. 2, 67) of Hoffman.

**Regarding claim 10**, the combination of Eng, Sears, and Hoffman teach the method of claim 7 wherein the data relating to mobile subscription choices [0039-0041] and the data representing at least one setting for the mobile device are adapted for use on a Binary Runtime Environment for Wireless (BREW) platform on the mobile device [0061] all of Sears.

**Regarding claim 11**, the combination of Eng, Sears, and Hoffman teach the method of claim 7 wherein the data relating to mobile subscription choices [0039-0041] and the data representing at least one setting for the mobile device are adapted for use on a Java platform on the mobile device [0039-0041] all of Sears.

**Regarding claim 12**, Eng, Sears, and Hoffman teach the method of claim 1 wherein the data relating to mobile subscription choices comprises an identification of a plurality of available service plans [0012-0013, 0036-0041] of Sears.

**Regarding claim 13**, Eng, Sears, and Hoffman teach the method of claim 1 wherein activating a service comprises selecting settings data associated with the selected subscription choice from stored respective sets of settings data associated with each of the mobile services subscriptions choices (Col. 1, line 19 to Col. 2, 67) of Hoffman.

**Regarding claim 14**, the combination of Eng, Sears, and Hoffman teach the method of claim 13 wherein the settings data comprises a preferred roaming list selected from a plurality of preferred roaming lists (Col. 1, line 19 to Col. 2, 67) of Hoffman.

**Regarding claim 15**, Eng, Sears, and Hoffman teach the method of claim 1 wherein the method is performed by a server remote from and in wireless communication with the mobile device (Col. 1, line 19 to Col. 2, 67) of Hoffman.

**Regarding claim 17**, Eng, Sears, and Hoffman teach the method of claim 16 wherein the particular service comprises a mobile voice communication service associated with the user selected service provider (Col. 1, line 19 to Col. 2, 67) of Hoffman.

**Regarding claim 18**, the combination of Eng, Sears, and Hoffman teach the method of claim 17 wherein the settings data comprises a preferred roaming list for the user selected service provider (Col. 1, line 19 to Col. 2, 67) of Hoffman.

**Regarding claim 19**, the combination of Eng, Sears, and Hoffman teach the method of claim 17 wherein the identified settings data identifies operational settings that (Col. 1, line 19 to Col. 2, 67), when installed on the mobile device (Col. 1, line 19 to Col. 2, 67), enable the mobile device to access the particular service provided by the user selected service provider (Col. 2, line 17 to Col. 3, line 67) all of Hoffman.

**Regarding claim 20**, the combination of Eng, Sears, and Hoffman teach the method of claim 17 'wherein the particular service is offered by a mobile virtual network operator (Col. 1, line 19 to Col. 2, 67) of Hoffman.

**Regarding claim 21**, Eng, Sears, and Hoffman teach the method of claim 16 wherein the application on the mobile device is adapted for use on a Binary Runtime Environment for Wireless (BREW) platform on the mobile device [0061] of Sears.

**Regarding claim 22**, Eng, Sears, and Hoffman teach the method of claim 16 wherein the application on the mobile device is adapted for use on a Java platform on the mobile device [0061] of Sears.

**Regarding claim 23**, Eng, Sears, and Hoffman teach the method of claim 16 wherein the plurality of services comprises a plurality of mutually exclusive mobile communication services (Col. 1, line 19 to Col. 2, 67) and the database of settings data stores settings data for each of the mutually exclusive mobile communication services (Col. 1, line 19 to Col. 2, 67) all of Hoffman.

**Regarding claim 25**, Eng, Sears, and Hoffman teach the mobile device of claim 24 wherein the server comprises an application download server (Col. 2, line 17 to Col. 3, line 67) of Hoffman.



**Regarding claim 26**, Eng, Sears, and Hoffman teach the mobile device of claim 24 wherein the client software comprises Binary Runtime Environment for Wireless (BREW) client software [0061] of Sears.

**Regarding claim 27**, the combination of Eng, Sears, and Hoffman teach the mobile device of claim 26 wherein the at least one application is adapted for execution by the BREW client software [0061] of Sears.

**Regarding claim 28**, Eng, Sears, and Hoffman teach the mobile device of claim 24 wherein the client software comprises Java virtual machine software [0061] of Sears.

**Regarding claim 29**, Eng, Sears, and Hoffman teach the mobile device of claim 24 wherein the received settings data comprises settings that enable wireless communications using a particular service provider (Col. 1, line 19 to Col. 2, 67) of Hoffman.

**Regarding claim 33**, Eng, Sears, and Hoffman teach the system of claim 32 wherein the services associated with the at least one mobile service provider comprise wireless communication services (Col. 1, line 19 to Col. 2, 67) of Hoffman.

**Regarding claim 34**, the combination of Eng, Sears, and Hoffman teach the system of claim 33 wherein the mobile device settings comprise settings necessary to enable the mobile devices to access the wireless communication services for the at least one mobile service provider (Col. 1, line 19 to Col. 2, 67) of Hoffman.

**Regarding claim 35**, the combination of Eng, Sears, and Hoffman teach the system of claim 33 wherein the mobile device settings comprise a plurality of preferred

roaming lists, with each preferred roaming list associated with a particular service provider (Col. 1, line 19 to Col. 2, 67) of Hoffman.

**Regarding claim 36**, the combination of Eng, Sears, and Hoffman teach the system of claim 35 wherein a preferred roaming list is sent to each mobile device (Col. 2, line 17 to Col. 3, line 67), with the preferred roaming list corresponding to a selection of a service provider received through the mobile communication system interface from the mobile device (Col. 1, line 19 to Col. 2, 67) all of Hoffman.

**Regarding claim 37**, the combination of Eng, Sears, and Hoffman teach the system of claim 33 wherein the at least one mobile service provider comprises a mobile virtual network operator (Col. 1, line 19 to Col. 2, 67) of Hoffman.

**Regarding claim 39**, Eng, Sears, and Hoffman teach the system of claim 32 wherein the applications are adapted for execution on a Binary Runtime Environment for Wireless (BREW) platform [0061] of Sears.

**Regarding claim 40**, Eng, Sears, and Hoffman teach the system of claim 32 wherein the mobile device settings comprise a software patch for one **or** more selected mobile devices (Col. 1, line 19 to Col. 2, 67) of Hoffman.

**Regarding claim 41**, Eng, Sears, and Hoffman teach the system of claim 32 wherein the mobile device settings comprise a telephone number [0012-0013, 0036-0041] of Sears.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL T. VU whose telephone number is (571)272-8131. The examiner can normally be reached on 8:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles N. Appiah can be reached on 571-272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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